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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,058	12/02/2003	Masayuki Kawazoe	100021-00136	2952
4372	7590	08/05/2005	EXAMINER	
ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036				WU, IVES J
ART UNIT		PAPER NUMBER		
		1713		

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/725,058	KAWAZOE ET AL.
	Examiner	Art Unit
	Ives Wu	1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 02 December 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/12/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 2, it cites the phrase "**GPF** to SAF", however, the "**GPF**" terminology does appear to lack antecedent basis in the specification. Since claim 2 is an original claim, applicant is permitted to amend the specification to include a reference to GPF grade.

### ***Claim Rejections - 35 USC § 112***

Claims 3 & 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "**high**" is cited in claim 3 & 7 is a relative term that renders the claims indefinite. This term is not defined in the balance of the claims and the specification does not provide a standard for ascertaining the requisite viscosity values. It is unclear what level of viscosity a given oil must possess in order to qualify as "**high**" viscosity within claims 3 & 7.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(1). Claims 1-4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. US006652641B2 in view of Hare et al (US003491052), Chen (EP1321488A1), Schmiegel (WO9823653A1).

Kawazura claims a process for producing modified carbon black for rubber reinforcement, which differs from applicant's claimed process in that (i) 100 parts by weight of a diene rubber latex is not mixed w/the modified carbon black and (ii) the resultant mixture is not subject to coagulating with a coagulator.

However, Hare et al (US003491052) disclose the coagulating after the blending of elastomers and other ingredients as cited: Also, where desired, other compounding agents, for instance pigments such as carbon black, extender or softener oils, vulcanizing agents and the like may be incorporated in the pseudo-emulsion prior to the coagulation step, Col. 3, lines 21-35; A coagulating agent, such as sulfuric acid or alum,

is fed at a predetermined, measured rate from the coagulant supply and introduced into the coagulator, Col. 5, lines 72-75.

It is well known in the art of rubber technology by the usage of coagulation process to separate the rubber compound crumb from the solvent because it is practical and feasible process to produce rubber compound. Also see reference of Chen (EP1321488A1), Schmiegel (WO9823653A1).

It would have been obvious at time of applicant's invention to include the coagulation step of Hare et al in the Kawazura process of producing the rubber compound with modified carbon black, motivated by a reasonable expectation of success. In re O'Farrell, 853 F.2d 894,903,7USPQ2d 1673, 1681 (Fed. Cir. 1988).

As to **dependent claim 2**, Hare et al disclose the usage of HAF carbon black in Example I, Col. 9, line 6; HAF grade carbon black is within the grade from GPF to SAF, page 70, "Rubber Technology, Maurice Morton, 3<sup>rd</sup> Ed"

As to **dependent claim 3**, Hare et al disclose the aromatic petroleum extending oil and 60 parts by weight in the Example V and Table I, Col.11, line 27-28.

As to **dependent claim 4**, it is disclosed in claim 2 of Kawazura (US006652641B2).

(2). Claims 5-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. US006652641B2 in view of Hare et al (US003491052).

As to the limitation of **independent claim 5**, the disclosure of Kawazura (US006652641B2) and Hare et al (US003491052) are incorporated herein by reference. The most subject matters of mixing, coagulation steps of producing the rubber composition containing modified carbon black and weight percentage of components in applicant's claim 15 has been recited in applicant's claim 1 and has been discussed in paragraph (1).

As to the process of producing the modified carbon black cited in **independent claim 5**, it is noted that product of modified carbon black with process limitation is embedded in the process claim 5, even though this modified carbon black in the claim 5 is limited by and defined by process, determination of patentability is based on the modified carbon black itself, not based on process of making, applicant's process of producing the modified carbon black is not given patentable weight in this claim of producing a rubber composition. *In re Thorpe*, 777 F.2d 695,698,277 USPQ 964, 966 (Fed. Cir. 1985)

As to **dependent claim 6**, it is disclosed in claim 2 of Kawazura et al (US20010009654A1).

As to the limitation of **dependent claim 7**, the disclosure of Kawazura (US006652641B2) and Hare et al (US003491052) are incorporated herein by reference. The most subject matter of 5 to 150 parts by weight of oil mixing in the rubber compound in applicant's claim 7 has been recited in applicant's claim 3 and has been

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discussed in paragraph (1). Hare et al (US003491052) further disclose to compound the extender or softener oils prior to the coagulation step, Col. 3, line 32-35.

As to **dependent claim 8**, it is disclosed in claim 2 of Kawazura (US006652641B2).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ives Wu whose telephone number is 571-272-4245. The examiner can normally be reached on 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Ives Wu  
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FRED TESKIN  
PRIMARY EXAMINER  
1913

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Date: July 26,2005